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MACNEILL, ELIZABETH

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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
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10 Ex parte DANIEL M. LIEBERMAN
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13 Appeal 2008-4415
14 Application 10/646,903
15 Technology Center 1600
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18 Oral Hearing Held: November 20, 2008
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21 Before DEMETRA MILLS, LORA GREEN and JEFFREY N. FREDMAN,
22 *Administrative Patent Judges*.
23

24 ON BEHALF OF THE APPELLANT:

25
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31 The above-entitled matter came on for hearing on Thursday,
32 November 20, 2008, commencing at 9:59 a.m., at the U.S. Patent and
33 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before
34 Suzie Dundas, Notary Public.

P R O C E E D I N G S

JUDGE MILLS: Calendar No. 58, Mr. Weiss.

(Pause.)

JUDGE MILLS: You are not accompanying the attorney at all or related to the Appellant in this case?

VOICE: No.

(Pause.)

MR. WEISS: May it please the Court, I apologize. I understand my name was called earlier. I wasn't aware of that.

JUDGE MILLS: Thank you. You have 20 minutes, of course, and you can begin when ready. If you wouldn't mind afterward giving the spelling of your name to the court reporter, or if you have a business card.

MR. WEISS: Absolutely. May it please the Court, I thought I would just focus. There are 14 claims at issue on this appeal, and I thought I would just focus on four of those, which I think will illustrate our position with respect to this rejection. With the exception of Claims 26 and 27, which I will not be discussing today, unless the panel has questions specifically about those, all of the rejections are based on 102, they're all anticipation rejections.

I'll start with Claims 14, 16 and 24. They're all independent method claims. All of these stand as being anticipated, rejected as being anticipated, based on the Wild reference. All of the claims in this case are directed to -- all the method claims, that is, are directed to methods for treating subdural hematomas involving stents that include draining subdural fluid collection and irrigating the subdural space.

1 The Wild reference is directed to an endoscopic assembly. It's simply
2 not a method for treating a subdural hematoma at all. So when we go
3 through these claims in a specific way, for instance a 102 rejection, the
4 Examiner to support the rejection would have needed to find specific
5 disclosure in Wild for each individual method step. That the Examiner
6 simply did not do.

7 If you start with Claim 24, I think perhaps it's easiest to see with
8 respect to Claim 24. There's a specific series of steps there. Those include
9 the insertion of a needle into the subdural space, the insertion of a guide wire
10 through that needle, the removal of the needle, and the insertion of a dual
11 lumen catheter along the guide wire. I should have mentioned the guide
12 wire is inserted parallel to the brain.

13 That sequence of steps is simply not present in Wild, and if you look
14 at the Examiner's answer, page six, where this is addressed, there's simply no
15 discussion of these individual claim steps that are all -- it's a very short
16 discussion indeed. It just basically says that the push-pull wires of Wild are
17 used to direct the catheter into position in the subdural space.

18 But again, there's no discussion of each of these individual steps, the
19 use of a needle, the insertion of the wire through the needle in a direction
20 that's parallel to the brain, removal of the needle and so forth.

21 JUDGE GREEN: I think the Examiner's decision that this is not used
22 to treat a subdural hematoma. I know he points to Column 1, line 53. I'd
23 like to ask for Appellant's position.

24 MR. WEISS: I think the language in Column 1 is a discussion of the
25 prior art, and specifically the discussion is about a unifunctional instrument,

1 unfunctional instruments in the prior art. That's the language at line 50 of
2 Column 1 of the Wild reference. Interestingly, if you look at the spec in our
3 case, we too talk about prior art unfunctional. We don't use that term
4 unfunctional, but we also talk about prior art, a prior art method which
5 involves a unfunctional instrument. In other words, it's simply a drainage
6 catheter.

7 So the Examiner in our view is going way too far when basically he or
8 she takes this language, this sole reference to a unfunctional instrument,
9 which we too recognize as being prior art, and then extrapolates from that an
10 entire use, methods steps that are simply not present or disclosed or taught in
11 Wild.

12 JUDGE FREDMAN: He's extrapolated a use not taught in Wild?

13 MR. WEISS: That's exactly my point. So when we then go from
14 there to Claim 16. Claim 16 again has some pretty specific method steps
15 there. We have these perforations on the drainage channel, and we also have
16 perforations along the irrigation channel as well. The drainage and the
17 irrigation occur through those perforations.

18 The Examiner does not identify that structure or the performance of
19 steps using that structure in Wild. There's a statement, a simple statement
20 that there are perforations, but there's no reference to a particular column or
21 line number, and we don't see any of that teaching in Wild.

22 With respect to Claim 14, which talks more generally about using a
23 lens on a catheter, having an irrigation step, a drainage step, there too, there's
24 no teaching of that in Wild. And again, as Judge Green pointed out, the

1 Examiner is placing almost exclusive reliance on this Background of the
2 Invention reference to --

3 JUDGE FREDMAN: For Claim 14, the Examiner took essentially an
4 endoscopes, right, which is what it is?

5 MR. WEISS: That's correct.

6 JUDGE FREDMAN: And he took the endoscopes and he put it into a
7 subdural space. Then he -- this is what he discusses, washes the cover of the
8 endoscopes to keep it clean, and it's then related to --. Would he not
9 essentially be irrigating the space with some sort of liquid, and then when he
10 removes that liquid he's not going to drain it from that space?

11 MR. WEISS: I think what you're describing is what the Examiner is
12 doing with Wild. Wild doesn't specifically teach, from what we can see,
13 using it specifically in the subdural space. I think it's just supposition as to
14 what might happen if in fact you took the device and, in contrast to what the
15 inventor stated in his 132 declaration, if in fact you tried to force it deeper
16 than it can actually go because of its rigidity, if you tried to force it into the
17 subdural space. If you then wash the lens, would it then have sort of these
18 impact effects?

19 JUDGE FREDMAN: So the point you're making is you don't think
20 that it was necessary for it be in the subdural space?

21 MR. WEISS: That's one of our arguments. That's correct, and that's
22 what set forth in Dr. Lieberman's 132 declaration. With respect to Claim 11,
23 which is the sole apparatus claim that's at issue here, there is a fairly specific
24 recitation of structure. We have an irrigation channel that's claimed as being
25 disposed inside of the drainage channel, and then it's supported by these

1 tubes, and the tubes permit fluid communication between the irrigation
2 channel and the subdural space.

3 The Examiner refers to Reference Nos. 9 and 10 in the Wild reference,
4 which are shown, Figure 17A and 17B, but a simple examination of those
5 figures shows that the one channel is not disposed within the second
6 channel. In addition, there is not that presence of supporting tubes to
7 support that structure. So there too, we would argue that that rejection
8 simply cannot be supported based on 102.

9 Those were the claims I wanted to focus on. I welcome any questions
10 that the panel may have.

11 JUDGE MILLS: Your position is that Wild does not disclose the
12 drainage channel at all, perforations defined by the drainage channel, or --

13 MR. WEISS: Wild has a channel which does appear to be useable for
14 purposes of draining out the fluid that is being used to wash the lens. So it's
15 not our position that Wild simply doesn't have a draining channel of any
16 kind. It's our position that, particularly with respect to the method claims,
17 we're talking about a specific method for treating a subdural hematoma.

18 Wild is not concerned with that. The drainage in Wild is not the
19 drainage of subdural collection fluid, and it's not teaching the irrigation of a
20 subdural space. Instead, it's simply teaching the washing of a lens and then
21 the removal of the washing fluid.

22 JUDGE MILLS: You do have an apparatus claim?

23 MR. WEISS: That's correct, and that's Claim 11. That was the last
24 one that we were discussing. That's the one in which the irrigation channel
25 is disclosed inside of a drainage channel and is supported by these tubes.

1 The tubes permit this fluid communication between the irrigation channel
2 and the subdural space. That's a -- you know again, I would like a pretty
3 specific recitation of structure. It's not in Wild.

4 The structures cited to by the Examiner, reference numbers 9 and 10,
5 show channels that are disclosed parallel to each other rather than one inside
6 the other.

7 JUDGE MILLS: That's all the questions I have.

8 MR. WEISS: Thank you very much.

9 JUDGE MILLS: Okay, thank you.

10 (Whereupon, at 10:08 a.m., the oral hearing was adjourned.)
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